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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/660,056	09/11/2003	William H. Fissell IV	UM-08332	7294
7590	01/24/2005		EXAMINER	
David A. Casimir MEDLEN & CARROLL, LLP Suite 350 101 Howard Street San Francisco, CA 94105			LAWRENCE JR, FRANK M	
			ART UNIT	PAPER NUMBER
			1724	
DATE MAILED: 01/24/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.	FISSELL ET AL.	
10/660,056	FISSELL ET AL.	
Examiner	Art Unit	
Frank M. Lawrence	1724	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

1) Responsive to communication(s) filed on \_\_\_\_.  
2a) This action is FINAL.                            2b) This action is non-final.  
3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

4) Claim(s) 1-44 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.  
5) Claim(s) 10-12 and 22-35 is/are allowed.  
6) Claim(s) 1-4, 7, 8, 13, 17-19, 21 and 36-44 is/are rejected.  
7) Claim(s) 5, 6, 9, 14-16 and 20 is/are objected to.  
8) Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

9) The specification is objected to by the Examiner.  
10) The drawing(s) filed on \_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) All    b) Some \* c) None of:  
1. Certified copies of the priority documents have been received.  
2. Certified copies of the priority documents have been received in Application No. \_\_\_\_.  
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

1) Notice of References Cited (PTO-892)  
2) Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_.

4) Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.  
5) Notice of Informal Patent Application (PTO-152)  
6) Other: \_\_\_\_.

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 36-44 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
3. Claim 36 recites the limitation "said membrane" in line 10. There is insufficient antecedent basis for this limitation in the claim. To overcome this rejection, the phrase should be changed to "a membrane." Claims 37-44 are rejected for depending from a rejected base claim.

### ***Specification***

4. The disclosure is objected to because of the following informalities: In line 3 of claim 7, "millimeters" should be changed to "millimeters."

Appropriate correction is required.

### ***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1-4, 7 and 8 are rejected under 35 U.S.C. 102(b) as being anticipated by Keller et al. (5,948,255).

7. Keller et al. '255 teach a microfabricated ultrafiltration system, comprising a membrane including elongated micromachined pores having a length in the range of 1-1000 microns and a width of 5-100 nanometers, a housing containing the membrane, and a fluid delivery passage through the housing to deliver fluid across the membrane. The membrane filter width is in the range of 1-3 mm, allowing the housing length and width to be less than 300 mm (see abstract, figures, col. 12, line 52 to col. 13, line 23, claims 1-7).

***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 13, 17-19 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Keller et al. '255 in view of Van Rijn (5,753,014).

10. Keller et al. '255 disclose all of the limitations of the claims except that the filter is used to filter biological fluid such as blood that is transferred to a subject without the use of a pump, and that the housing is biocompatible. Van Rijn '014 discloses a micromachined, biocompatible ultrafiltration membrane that can be used to filter blood *in vivo* (see abstract, col. 1, lines 50-56, col. 2, lines 44-58, col. 5, lines 1-34, col. 13, lines 3-14). It would have been obvious to one having ordinary skill in the art at the time of the invention to utilize the filter produced in the Keller et al. patent to filter blood *in vivo* and to use biocompatible materials in order to provide a blood filter having a known useful pore size that will not harm a subject.

***Allowable Subject Matter***

11. Claims 10-12 and 22-35 are allowed.
12. The following is an examiner's statement of reasons for allowance: The prior art of record fails to disclose or suggest the use of an electrode positioned on or near a membrane having nanofabricated pores for generating an electric field in or near the pores, a sensor within a housing containing the membrane, or a population of cells attached to the membrane.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

13. Claims 5, 6, 9, 14-16 and 20 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.
14. Claim 36 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action.

15. Claims 37-44 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

***Conclusion***

16. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The additional references listed on the attached PTO-892 form disclose membrane filtration systems.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Frank M. Lawrence whose telephone number is 571-272-1161. The examiner can normally be reached on Mon-Thurs 7:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Duane Smith can be reached on 571-272-1166. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Frank M. Lawrence  
Primary Examiner  
Art Unit 1724

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*Frank Lawrence*

1-4-05